



**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q79484

Takuo SONE, et al.

Appln. No.: 10/759,299

Group Art Unit: 1713

Confirmation No.: 7184

Examiner: Kelechi Chidi Egwim

Filed: January 20, 2004

For: METHOD OF PRODUCING CONJUGATED DIENE POLYMERS

**REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated May 15, 2006. Entry of this Reply Brief is respectfully requested.

**Table of Contents**

STATUS OF CLAIMS .....	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL .....	3
ARGUMENT .....	4
CONCLUSION.....	4

REPLY BRIEF UNDER 37 C.F.R. § 41.41  
U.S. Appln. No.: 10/759,299

**STATUS OF CLAIMS**

Claims 1-15 and 18-20, all of which are rejected, are the subject of this appeal. Claims 16-17 are canceled. The claims are set forth in their entirety in the Appendix attached to the Brief on Appeal.

REPLY BRIEF UNDER 37 C.F.R. § 41.41  
U.S. Appln. No.: 10/759,299

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The rejection of Claim 1-15 and 18-20 under 35 U.S.C. § 103(a) over Ikematsu et al., JP 05059103 (Ikematsu '103) or Ikematsu et al., JP 05051406 ("Ikematsu '406"), in combination with Tsujimoto et al., JP 8073515, is to be reviewed on appeal.

### **ARGUMENT**

In the Examiner's Answer, the Examiner states that the Summary of the Claimed Subject Matter Section in the Appeal Brief is deficient because the explanation provided is broader than what is actually claimed in the independent claims. However, if the Summary of the Claimed Subject Matter Section is considered "deficient" then it would fail to provide an explanation of the subject matter defined in each of the independent claims. As pointed out by the Examiner, the Summary of the Claimed Subject Matter Section in the Appeal Brief provides more description or is broader than what is defined in the claims. Thus, the Summary of the Claimed Subject Matter Section cannot be "deficient" as asserted by the Examiner.

Additionally, the Summary of the Claimed Subject Matter Section is intended to enable the Board to more quickly determine where the claimed subject matter is described in the application. MPEP 1205.02. There is no requirement that the Summary of the Claimed Subject Matter Section be limited to the scope of the independent claims. In fact, the section is labeled as a "summary," and thus it should summarize what is claimed in the independent and dependent claims and appropriately reference where this subject matter can be found in the specification of the application, which the Summary of the Claimed Subject Matter Section provided in Appellants' Appeal Brief does.

Further, in the Examiner's Answer, the Examiner states that Appellants' runs in the § 132 Declaration are not one-to-one comparisons. The Examiner also asserts that the claims are much broader than the compounds represented in the specification.

The non-obviousness of a broader claimed range can be supported by evidence based on unexpected results from testing a narrower range if one of ordinary skill in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof. MPEP 716.02(d); *In re Kollman*, 595 F.2d 48, 201 USPQ 193 (CCPA 1979).

It is clear from the § 132 Declaration as well as Appellants' remarks in the Appeal Brief that Run-1 and Run-2 are one-to-one comparisons which demonstrate the unexpected superiority of the claimed invention. As discussed on page 17 of the Appeal Brief, Run-1 corresponds to Example 11 of the present invention and Run-2 is a Comparative Example in the Tsujimoto '515 (a supplementary experiment of Tsujimoto '515). Based on the results in Run-2, it would be expected that when combining the catalyst system described in Tsujimoto '515 and subjecting to a coupling reaction with the ester compound described in Ikematsu '406 (Run-1), the wear resistance and the low heat buildup would be deteriorated because the molecular weight distribution is broader than the weight distribution of Run-2. However, the properties of Run-1 are unexpectedly superior as compared with Run-2, which is contrary to the knowledge in the art and it would be impossible to predict this effect based on the teachings of Ikematsu '406 and Tsujimoto '515.

REPLY BRIEF UNDER 37 C.F.R. § 41.41  
U.S. Appln. No.: 10/759,299

**CONCLUSION**

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.


Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

  
Jennifer R. Leach  
Registration No. 54,257

Date: July 14, 2006